

Amendments to the Drawings:

The attached drawing sheet includes a change to FIG. 1A. In FIG. 1A, reference numbers 81' has been deleted.

REMARKS

The applicant appreciates the Examiner's attention to detail in the preparation of the pending Office Action and the indication of some allowable subject matter therein. In view of the Examiner's claim rejections, the applicant has amended certain claims and provided the following remarks. The applicant respectfully submits that the claims, as amended, are in condition for allowance. Currently, claims 38 – 42, 44 – 53, 55 – 57, 59 – 66, 68 – 103, 105 – 115 are pending. Claims 1 – 37, 43, 54, 58, 67, 104 and 116-123 have been cancelled without prejudice.

In the Specification

In order to expedite issuance of the present application, the specification has been amended to remove subject matter that the Examiner indicated as being "new matter." Specifically, paragraph [0053] has been amended to delete reference to throttle body 81' shown in FIG. 1A. In conjunction therewith, the attached sheet of drawings includes an amendment to FIG. 1A. This sheet, which include FIGS. 1A, replaces the original drawing sheet. In FIG. 1A, reference number 81' has been deleted.

Claim Objections

The Applicant has amended the claims in accordance with the Examiner's suggested corrections.

Claim Rejections under Section 112

The Applicant has amended each of the claims pointed out by the Examiner in view of the rejection under Section 112, second paragraph. The Applicant respectfully submits that each of the claims is now in condition for allowance.

Claim Rejections under Sections 102

The Examiner has rejected claim 38 as being anticipated by Ruf et al. The applicant notes that anticipation requires that each and every element of the claimed invention be disclosed in a single prior art reference or embodied in a single prior art device or practice. *Minnesota Min. & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992); *In re Spada*, 911 F.2d 705, 15 USPQ2d 1655 (Fed. Cir. 1990). In addition those elements must either be inherent or disclosed expressly and must be arranged as in the claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913 (Fed. Cir. 1989). Thus, for anticipation, there must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. *Scripps Clinic & Res. Found. v. Genentech, Inc.*, 927 F.2d 1560, 7 USPQ2d 1057 (Fed. Cir. 1988). Absence from the reference of any claimed element negates

anticipation. *Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565, 230 USPQ 81 (Fed. Cir. 1986).

Claim 38 as amended now recites:

38. A turbocharger system for a vehicle having an internal combustion engine, an exhaust pipe coupled to the internal combustion engine and a space defined by the vehicle normally occupied by a muffler, comprising:
a turbocharger;
an oiling system coupled to the turbocharger for supplying oil to the bearings of the turbocharger; and
mounting hardware mounting the turbocharger to the exhaust pipe of the vehicle at least partially in the space normally occupied by the muffler.

The applicant respectfully submits that Claim 38 is not taught by the Ruf et al. Specifically, Ruf et al. fails to teach "mounting hardware mounting the turbocharger to the exhaust pipe of the vehicle at least partially in the space normally occupied by the muffler." Accordingly, the applicant respectfully submits that claim 38 is in condition for allowance.

Claim Rejections under Sections 103

The Examiner has rejected claims 39-42 and 44 as being unpatentable over Ruf et al. in view of Widenhorn, claim 45 in further view of Minami et al., claims 46-47 in further view of "Design Choice", claims 48 and 50 in further view of Pleuss et al., claim 49 in view of Evenko, claim 51 in view of Widenhorn and in further view "Design Choice," and claim 52 in further view of Werner. The applicant respectfully submits that to the extent that each of these claims depend from an allowable base claim, such dependent claims are also allowable over the prior art of record.

With respect to rejections under Section 103, the burden is on the Examiner to establish a case of *prima facie* obviousness. *In re Fine* 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). The test for establishing such a case is well stated in *In re Lintner*, 173 U.S.P.Q. 560, 562 (C.C.P.A. 1972) as follows:

In determining the propriety of the Patent Office case for obviousness in the first instance, it is necessary to ascertain whether or not the reference teaching would appear to be sufficient for one of ordinary skill in the relevant art having the reference before him to make the proposed substitution, combination or other modification.

Furthermore, the C.C.P.A. held in *In re Kuderna*, 165 U.S.P.Q. 575 (C.C.P.A. 1970):

We must approach the issue of patentability in terms of what would have been obvious to one of ordinary skill in the art at the time the invention was made in view of the sum of all the relevant teachings in the art, not in view of the first one and then another of the isolated teachings in the art. . . . Where is the reason for one skilled in the art to so emphasize that one isolated teaching?

An excellent summary of how the prior art must be considered to make a case of *prima facie* obviousness is contained in *In re Ehrreich*, 200 U.S.P.Q. 504, 509-11 (C.C.P.A. 1979). There, the court stated that a reference must not be considered in a vacuum but against the background of the other references of record. It is stated that the question of a § 103 case is what the reference(s) would “collectively suggest” to one of ordinary skill in the art. However, the court specifically cautioned that the Examiner must consider the entirety of the disclosure made by the reference and avoid combining them indiscriminately.

In finding that the "subject matter as a whole" would not have been obvious in *Ehrreich* the court concluded:

Thus, we are directed to no combination of prior art references which would have rendered the claimed subject matter as a whole obvious to one of ordinary skill in the art at the time the invention was made. The PTO has not shown the existence of all the claimed limitations in the prior art or a suggestion leading to their combination in the manner claimed by appellants.

The applicant does not dispute that, if one searches the art hard enough, each feature of a claimed invention may be found in some isolated teaching. However, that is not the point of "invention." It has been widely recognized that virtually every invention is a combination of elements and that most, if not all, of these will be found somewhere in an examination of the prior art. This reasoning led the Federal Circuit, in *Connell v. Sears, Roebuck & Co.*, 220 U.S.P.Q. 193, 199 (Fed. Cir. 1983) to state:

The test is whether the claimed invention as a whole, in light of all the teachings of the references in their entireties, would have been obvious to one of ordinary skill in the art at the time the invention was made.

To establish a *prima facie* case of obviousness with respect to a claimed composition, the prior art must provide some reason or motivation to make the claimed composition, *In re Dillon*, 16 U.S.P.Q.2d 1897, 1901 (Fed. Cir. 1990) (*en banc*). As more recently and aptly stated in *In re Jones*, 21 U.S.P.Q.2d 1941, 1944 (Fed. Cir. 1992) (emphasis in original):

Conspicuously missing from this record is any *evidence*, other than the PTO's speculation (if it be called evidence) that one of ordinary skill in the . . . art would have been motivated to make the modifications of the prior art necessary to arrive at the claimed [invention].

With respect to properly considering the prior art, the C.C.P.A. stated in *In re Carroll*, 202 U.S.P.Q. 571, 572 (C.C.P.A. 1979), as follows:

One of the more difficult aspects of resolving questions of non-obviousness is the necessity “to guard against slipping into use of hindsight.” *Graham v. John Deere Co.*, 383 U.S. 1, 36, 148 USPQ 459, 474 (1965). Many inventions may seem obvious to everyone after they have been made. However, 35 USC 103 instructs us to inquire into whether the claimed invention “would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.” Thus, in deciding the issue of obviousness, we must look at the prior art presented from a vantage point in time prior to when the invention was made, and through the eyes of a hypothetical person of ordinary skill in the art.

When making a rejection under 35 U.S.C. § 103 there are three fundamental areas the Examiner is required, under 37 C.F.R. § 1.106 and MPEP § 706.02, to cover to fulfill the test enunciated in *Graham v. John Deere*, 383 U.S. 1, 148 U.S.P.Q. 454 (1966). First, the rejection should set forth the differences between the claims and the prior art. Second, the proposed modification of the applied references necessary to arrive at the claimed subject matter should be set out. Third, there must be an explanation why such proposed modifications would be obvious.

The Examiner has rejected claims 65-66 and 69 as being unpatentable over Minami et al. in view of Ruf. Claim 65 as amended now recites:

65. A turbocharger installation kit for a vehicle having a combustion engine disposed within an engine compartment and an oiling system having an oil system pump and an oil reservoir for lubricating the combustion engine, comprising:
a turbocharger;
an oil pump for coupling between the turbocharger and the oiling system of the vehicle to pump oil back to the oiling system of the vehicle;
first exhaust plumbing having a first end configured for mounting to an exhaust system of the engine and a second end, the first exhaust plumbing configured for extending from the engine compartment to an underside of the vehicle;
first mounting hardware configured for mounting the turbocharger to the second end of the first exhaust plumbing and not to the combustion engine;

a first oil line configured for coupling between the oiling system of the vehicle and the turbocharger; and
a second oil line for coupling between the oil pump and the oiling system of the vehicle.

The applicant respectfully submits that the prior art of reference fails to teach or suggest “first exhaust plumbing having a first end configured for mounting to an exhaust system of the engine and a second end, the first exhaust plumbing configured for extending from the engine compartment to an underside of the vehicle.”

Referring to claim 75, the claim now recites:

75. A turbocharger system for a vehicle defining an engine compartment and having an internal combustion engine disposed within the engine compartment and an exhaust pipe coupled to the combustion engine and extending from proximate the engine to outside the engine compartment, comprising:
a turbocharger, said turbocharger including an oil inlet configured for being coupled to a pressure side of said oiling system, an oil outlet, an exhaust inlet, an exhaust outlet, an air charge inlet, and an air charge outlet;
an oiling system coupled to the turbocharger for supplying oil to the bearings of the turbocharger;
mounting hardware for mounting the turbocharger to the exhaust pipe at a location outside the engine compartment and not to the internal combustion engine;
an air filter coupled to the air charge inlet of the turbocharger; and
a duct coupling said air filter to said turbocharger.

The prior art fails to teach or suggest that the combination of claim elements as recited therein. In particular, Ruf fails to teach “mounting hardware for mounting the turbocharger to the exhaust pipe at a location outside the engine compartment and not to the internal combustion engine.” Thus, the combination proposed by the examiner fails to teach or suggest the claimed invention and claim 75 should be in condition for allowance.

Referring to claim 82, the claim now recites:

82. A turbocharger system for an internal combustion engine, comprising:
a turbocharger;
an oil pump coupled to the turbocharger for supplying oil to the bearings of the turbocharger;
mounting hardware for mounting the turbocharger to an exhaust pipe of a vehicle and not to the internal combustion engine; and
a water injection system coupled to a charge air tube for injecting water into a flow of gases exiting the turbocharger to cool the flow of gases.

The prior art fails to teach or suggest that the combination of claim elements as recited therein. In particular, Ruf fails to teach “mounting hardware for mounting the turbocharger to an exhaust pipe of a vehicle and not to the internal combustion engine.” Thus, the combination proposed by the examiner fails to teach or suggest the claimed invention and claim 82 should be in condition for allowance.

Referring to claim 87, the claim now recites:

87. A method of mounting a turbocharger to an internal combustion engine driven vehicle, comprising:
mounting an exhaust inlet of the turbocharger to an exhaust pipe extending at least partially along the underside of the vehicle, the turbocharger having an oil inlet and an oil outlet;
coupling an oil pump in fluid communication with the oil outlet of the turbocharger and a reservoir side of an oil system; and
providing a modified engine oil fill cap with fittings to couple to an oil return line extending between the oil pump and the fill cap.

The prior art fails to teach or suggest that the combination of claim elements as recited therein. In particular, Minami fails to teach “mounting an exhaust inlet of the turbocharger to an exhaust pipe extending at least partially along the underside of the

vehicle.” Thus, the combination proposed by the examiner fails to teach or suggest the claimed invention and claim 87 should be in condition for allowance.

Referring to claim 90, the claim now recites:

90. A turbocharger installation kit for combustion engine, comprising:
a turbocharger;
an oil pump for coupling to the turbocharger to assist in the flow of oil through the turbocharger;
first exhaust plumbing configured for coupling said turbocharger to a flow of exhaust from an engine of a vehicle;
first mounting hardware configured for mounting the turbocharger to the underside of the vehicle and not to the engine at a location away from an engine compartment of the vehicle;
a first oil line configured for coupling between an oiling system of the vehicle and the turbocharger;
a second oil line for coupling between the oil pump and the oiling system of the vehicle; and
a valve for coupling to the first oil line and for preventing oil flow into the turbocharger when the engine is not running.

The prior art fails to teach or suggest that the combination of claim elements as recited therein. In particular, Minami and Ruf fail to teach or suggest “first mounting hardware configured for mounting the turbocharger to the underside of the vehicle and not to the engine at a location away from an engine compartment of the vehicle.” Thus, the combination proposed by the examiner fails to teach or suggest the claimed invention and claim 90 should be in condition for allowance.

Referring to claim 100, the claim now recites:

100. A turbocharger installation kit for a combustion engine, comprising:
a turbocharger;
an oil pump for coupling to the turbocharger to assist in the flow of oil through the turbocharger;

first exhaust plumbing configured for coupling said turbocharger to a flow of exhaust from an engine of a vehicle;
second exhaust plumbing for coupling to the turbocharger and exiting exhaust from the turbocharger;
first mounting hardware configured for mounting the turbocharger to the underside of the vehicle and away from the engine and engine compartment of the vehicle;
a first oil line configured for coupling between an oiling system of the vehicle and the turbocharger;
a second oil line for coupling between the oil pump and the oiling system of the vehicle; and
second mounting hardware configured for mounting the oil pump to an underside of the vehicle.

The prior art fails to teach or suggest that the combination of claim elements as recited therein. In particular, Minami and Ruf fail to teach or suggest "first mounting hardware configured for mounting the turbocharger to the underside of the vehicle and away from the engine and engine compartment of the vehicle." Thus, the combination proposed by the examiner fails to teach or suggest the claimed invention and claim 100 should be in condition for allowance.

Referring to claim 100, the claim now recites:

109. A turbocharger installation kit for combustion engine, comprising:
a turbocharger;
an oil pump for coupling to the turbocharger to assist in the flow of oil through the turbocharger;
first exhaust plumbing configured for coupling said turbocharger to a flow of exhaust from an engine of a vehicle;
mounting hardware configured for remotely mounting the turbocharger to an underside of the vehicle away from an engine and engine compartment of the vehicle;
a first oil line configured for coupling between an oiling system of the vehicle and the turbocharger;
a second oil line for coupling between the oil pump and the oiling system of the vehicle; and
an electrical harness, switch, and relay for providing variable voltage to the oil pump to adequately meet the varying flow requirements of the turbocharger by reducing the

speed of and thus the noise output of the oil pump when flow requirements are reduced.

The prior art fails to teach or suggest that the combination of claim elements as recited therein. In particular, Minami and Ruf fail to teach or suggest "mounting hardware configured for remotely mounting the turbocharger to an underside of the vehicle away from an engine and engine compartment of the vehicle." Thus, the combination proposed by the examiner fails to teach or suggest the claimed invention and claim 109 should be in condition for allowance.

The applicant respectfully submits that each of the amendments to the claims find support in the specification and drawings. Thus, no new matter has been added by the foregoing amendments to the claims. The applicant respectfully submits that the pending claims are now in condition for allowance.

CONCLUSION

The applicant respectfully submits that the present application is in condition for allowance and requests that a Notice of Allowance be issued in this case. If further action is necessary that can be resolved by Examiner Amendment, the Examiner is welcome to call the

undersigned in order to expedite issuance. The Commissioner is authorized to charge any fees due pursuant to this amendment to deposit account 50-0881.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Frank W. Compagni', written over the printed name.

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